

REMARKS

Claims 1-21 were pending in this Application before this Amendment. In the Office
Action:

- Claim 4 was objected to because, according to the Examiner, “a two-bar grating” in line 1 of claim 4 should be “said two-bar grating” since it is referring to the same grating in claim 3.
- Claim 19 was objected to as being of improper dependent form for failing to further limit the subject matter of a previous claim. According to the Examiner, product-by-process claims are limited to the structure implied by the steps of the process, rather than being limited to the manipulations of the recited steps, and claim 19 is not limited to the steps of claim 1 in that the steps fail to structurally distinguish the product.
- Claims 1-6 and 16-21 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pub. No. 2003/0048458 to Mieher, et al. (“Mieher”).
- Claims 10-15 were objected to as being dependent upon a rejected based claim, but according to the Examiner, would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As a result of this Amendment, claims 2, 8-18, 20 and 21 remain pending in the present application. Claims 1, 3-7 and 19 are being cancelled without prejudice or disclaimer. Claim 8 is being amended to independent form, including the limitations of its original base claim. Claims 2 and 9 are being amended to depend from claim 8. Claim 10 is being amended to

independent form, including all the limitations of its original base claim (claim 1). Claims 16 and 20 are being amended to depend from claim 10.

Reconsideration of this application is respectfully requested in view of the foregoing amendments and the following remarks.

A. Objection to Claims 10-15

Claims 10-15 were objected to as being dependent upon a rejected based claim, but according to the Examiner, would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In response, claim 10 has been rewritten in independent form, including all the limitations of the base claim (original claim 1). There was no intervening claim. Because claims 11-15 originally depended from claim 10, either directly or indirectly, they need not be rewritten in independent form. The rewriting of claim 10 in independent form should be enough to overcome the objection.

Claims 16 and 20 also have been amended to depend from claim 10. Each of claims 17, 18 and 21 depends directly from one of claims 16 and 20. As a result, claims 17, 18 and 21 depend indirectly from claim 10. To the extent each of claims 16-21 depends directly or indirectly from claim 10, it is respectfully submitted that claims 16-21 are allowable over the cited art for at least the same reasons as claim 10.

Applicants thank the Examiner for the indication of allowable subject matter and for taking the time to express the reasons for allowance. In providing those reasons, however, the subject matter recited in the claims was summarized to the extent that some of the claimed

features were not expressly recited and others seem to have been emphasized. Applicants respectfully traverse the expressed reasons for allowance. The subject matter of the indicated-to-be-allowable claims are patentable for their respective recitations of claimed combinations as a whole, without any particular criticality or distinguishing feature being attributable to any one or more of such features, and without any narrowing interpretation being imposed on any of such features.

B. Objections to Claims 4 and 19

Claim 4 was objected to because, according to the Examiner, “a two-bar grating” in line 1 of claim 4 should be “said two-bar grating” since it is referring to the same grating in claim 3. Claim 19 was objected to as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Both of claims 4 and 19 are being cancelled without prejudice or disclaimer. The objections to claims 4 and 19 therefore are being obviated by this Amendment.

C. Rejection of Claims 1-6 and 16-21 under 35 U.S.C. § 102(e) as being anticipated by Mieher

Claims 1-6 and 16-21 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pub. No. 2003/0048458 to Mieher, et al. (“Mieher”).

Applicants respectfully traverse the rejection to the extent the effective filing date of the Mieher publication under 35 U.S.C. § 102(e) is later than the date upon which Applicants invented the claimed subject matter. To expedite prosecution and avoid investigating and/or gathering the evidence of prior invention at this time, however, claims 1, 3-7 and 19 are being

cancelled without prejudice or disclaimer. Applicants reserve the right to pursue the subject matter of claims 1, 3-7 and 19 in a subsequent continuation or other application.

With respect to claims 2, 8 and 9, even if it is assumed for the sake of argument that Mieher constitutes prior art under § 102(e), claims 2, 8 and 9, as amended, patentably distinguish over the teachings of Mieher because they recite at least one feature that is absent from the Mieher teachings. A rejection under 35 U.S.C. § 102(e) is proper only if the cited art teaches *each and every* feature recited in the claims. Mieher fails to do so.

Claims 2 and 9, as amended, depend from claim 8. Claim 8 recites all of the features previously recited in original claims 1 and 7, and it further recites that the “information” includes information indicative of three-wave aberrations. Nothing in the Mieher reference teaches or suggests the inclusion of information indicative of three-wave aberrations—let alone the inclusion of such information in a method having all the other features recited in amended claim 8. Mieher therefore cannot anticipate claim 8.

Claims 2 and 9 include the patentably distinguishing combination by virtue of their dependent relationship with claim 8. The rejection of claims 2, 8 and 9 under 35 U.S.C. § 102(e) therefore should be withdrawn.

The rejection under 35 U.S.C. § 102(e) also should be withdrawn with respect to claims 16-21 because, as indicated above, each of claims 16-21 depends directly or indirectly from claim 10 and includes the features that the Examiner deemed allowable in claim 10.

In view of the foregoing, all of the claims in this case are believed to be in condition for allowance. Should the Examiner have any questions or determine that any further action is

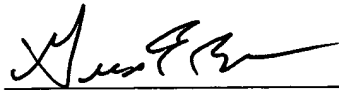
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desirable to place this application in even better condition for issue, the Examiner is encouraged to telephone applicants' undersigned representative at the number listed below.

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